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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,086	12/21/2001	Robert E. Denman	22171.299	1095

27683 7590 09/27/2005

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EXAMINER

PHILLIPS, HASSAN A

ART UNIT PAPER NUMBER

2151

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,086

Applicant(s)

DENMAN ET AL.

Examiner

Hassan Phillips

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to communication received and filed on December 21, 2001.

Drawings

2. The replacement drawings were received on April 11, 2002.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: (26) see page 12, paragraph 19. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

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requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

5. Claim 2 is objected to because of the following informalities: a period is missing at the end of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no apparent description of a "signaling plane component" or a "media plane component" in the specification. Accordingly, to advance prosecution of the application for patent Examiner has interpreted the claim as best understood.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 15, 26, and 36, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 15 and 26 recite the limitation "the PTT Server" in lines 4 and 8, of the claims respectively. There is insufficient antecedent basis for this limitation in the claims.

11. Claim 36 recites the limitation "RPTMG" in line 9, of the claims respectively. There is insufficient antecedent basis for this limitation in the claims. Examiner has interpreted the claim as best understood.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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13. Claims 1-19, 23, 35, are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Maggenti et al. (hereinafter Maggenti), U.S. Patent 6,477,150.

14. In considering claim 1, Maggenti teaches a wireless communication network including push-to-talk (PTT) functionality, comprising: a Session Initiation Protocol (SIP) Proxy Server (218), (col. 5, lines 38-55, Fig.'s 2 and 6); a SIP Registrar and Location Server (218) operable to store contact addresses of active mobile devices, (col. 7, lines 15-28, Fig.'s 2 and 6); a PTT Server (218) operable to function as a call endpoint for each of a plurality of mobile devices wherein the plurality of mobile devices are segmented into membership groups, the PTT Server further operable to multicast a communication from one member of the group to the other members of the group, (col. 4, line 49-col. 5, line 46, col. 22, lines 45-58, Fig.'s 2 and 6); and an Internet Protocol (IP) network (214) interconnecting the SIP Proxy server, the SIP Registrar and Location Server, and the PTT Server, (col. 15, lines 28-37, Fig.'s 2 and 6).

15. In considering claim 2, Maggenti teaches the PTT server including a signaling plane component and a media plane component, (col. 20, lines 49-57, Fig. 6).

16. In considering claim 3, Maggenti teaches a subscriber database operable to store subscriber data, (col. 7, lines 15-28, Fig. 6).

17. In considering claim 4, Maggenti teaches a radio access network operable to wirelessly link the plurality of mobile devices to the IP network, (col. 6, lines 24-47, Fig. 2).

18. In considering claim 5, Maggenti teaches a method for user activation of push-to-talk (PTT) service in a wireless communication network, comprising: initiating a session with a PTT server wherein a user joins a group, (col. 10, lines 46-55); registering a contact for the user, (col. 10, lines 46-55); wherein the contact for the user is the PTT server, (col. 10, lines 46-55).

19. In considering claim 6, Maggenti teaches the group being closed with pre-provisioned members, (col. 10, line 56- col. 11, line 6).

20. In considering claim 7, Maggenti teaches the group being open whereby any user can join, (col. 10, line 56- col. 11, line 6).

21. In considering claim 8, Maggenti teaches initiating a session including invoking a SIP INVITE process, (col. 11, lines 52-59).

22. In considering claim 9, Maggenti teaches a To header of the SIP INVITE including a group specific Uniform Resource Locator, (col. 25, lines 12-28).

23. In considering claim 10, Maggenti teaches registering a contact for the user (col. 10, lines 46-55). Maggenti also teaches operating over the SIP protocol, (col. 7, lines 39-57). Thus, it is inherent in the teachings of Maggenti that registering a contact for the user includes invoking a SIP REGISTER process, since SIP REGISTER is a conventional method.

24. In considering claim 11, Maggenti teaches registering a contact for the user including registering a group specific Uniform Resource Locator, (col. 10, lines 46-55).

25. In considering claim 12, Maggenti teaches the PTT server functioning as a SIP user agent server (col. 11, line 60-col. 12, line 2), and as a multicast router (col. 22, lines 51-58).

26. In considering claim 13, Maggenti teaches the contact for the user being a SIP URL for the group in the PTT server, (col. 26, lines 5-43).

27. In considering claim 14, Maggenti teaches initiating a session with the PTT server including the PTT server adding the IP address of the user's mobile device to a multicast group, (col. 10, lines 46-55).

28. In considering claims 15 and 35, Maggenti teaches a method for push-to-talk (PTT) group calls for users in a wireless communication network, comprising: pressing a

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PTT button on a mobile device, (col. 6, lines 11-23); transmitting to the PTT server from the mobile device to request the group's speech token, (col. 6, lines 11-23); receiving an acknowledge message at the mobile device from the PTT Server wherein the acknowledge message includes a speech token, (col. 6, lines 11-23); transmitting a half-duplex speech communication from the mobile device to the PTT Server, (col. 20, lines 26-30); multicasting the half-duplex speech communication from the PTT server to other members of a group, (col. 4, lines 49-59, col. 22, lines 51-58); releasing the PTT button on the mobile device, (col. 6, lines 11-23); transmitting to the PTT server to release speech token, (col. 6, lines 11-23); notifying the group members that the speech token is available, (col. 6, lines 11-23, col. 31, lines 38-48). Maggenti also teaches operating over the SIP protocol, (col. 7, lines 39-57). Thus, it is inherent in the teachings of Maggenti that a SIP SUBSCRIBE is transmitted to the PTT server from the mobile device to request the group's speech token, since SIP SUBSCRIBE is a conventional method.

29. In considering claim 16, it is inherent in the teachings of Maggenti that multicasting includes use of a Class D Multicast address, (col. 4, lines 49-59, col. 22, lines 51-58).

30. In considering claim 17, Maggenti teaches the multicasting including use of network address and port translation by the PTT server, whereby the PTT server replaces a destination IP address of a port number of received speech packets with an

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IP address of a port number of each target user and unicasts modified packets to each target user, (col. 6, line 62-col. 7, line 7).

31. In considering claim 18, Maggenti teaches authorizing priority members to pre-empt any other group member who has been granted the speech token, (col. 30, line 63-col. 31, line 9).

32. In considering claim 19, Maggenti teaches identifying the caller to target users, (col. 12, line 64-col. 13, line 11).

33. In considering claim 23, Maggenti teaches sending a releasing member the status of the token in the response to the releasing SUBSCRIBE request, (col. 31, lines 38-59).

Claim Rejections - 35 USC § 103

34. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35. Claims 20-22, 24-34, 36, are rejected under 35 U.S.C. 103(a) as being unpatentable over Maggenti.

36. In considering claim 20, although the teachings of Maggenti disclose substantial features of the claimed invention, they fail to expressly disclose: SIP INFO and NOTIFY messages being used to convey a calling party ID.

Nevertheless, INFO and NOTIFY messages are conventional SIP messages and were well known in the art at the time of the present invention for mid-call signaling information exchanging, and event notification after an explicit/implicit subscription, respectively.

Thus, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Maggenti to show SIP INFO and NOTIFY messages being used to convey a calling party ID. This would have advantageously provided a conventional means for identifying callers to target users, (Maggenti, col. 12, line 64-col. 13, line 11).

37. In considering claims 21 and 30, although the teachings of Maggenti disclose substantial features of the claimed invention, they fail to expressly disclose: sending a SIP INFO message indicating the speech token is available.

Nevertheless, INFO messages were well known in the art at the time of the present invention for mid-call signaling information exchanging.

Thus, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Maggenti to show sending a SIP INFO message indicating the speech token is available. This would have advantageously provided a conventional means for

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notifying group members that a speech token is available, (Maggenti, col. 6, lines 11-23, col. 31, lines 38-48).

38. In considering claims 22 and 31, although the teachings of Maggenti disclose substantial features of the claimed invention, they fail to expressly disclose: sending a SIP NOTIFY message indicating the speech token is available.

Nevertheless, NOTIFY messages were well known in the art at the time of the present invention for event notification after an explicit/implicit subscription.

Thus, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Maggenti to show sending a SIP NOTIFY message indicating the speech token is available. This would have advantageously provided a conventional means for notifying group members that a speech token is available, (Maggenti, col. 6, lines 11-23, col. 31, lines 38-48).

39. In considering claims 24 and 32, although the teachings of Maggenti disclose substantial features of the claimed invention, they fail to expressly disclose: notifying the group members that the speech token is available including multicasting a pre-stored tone from the PTT server.

Nevertheless, Maggenti teaches notifying the group members that the speech token is available, (col. 31, lines 38-48), and notifying a requesting group member that a speech token has been granted by means of a pre-stored tone, (col. 6, lines 11-23).

Thus, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Maggenti to show notifying the group members that the speech token is available including multicasting a pre-stored tone from the PTT server. This would have advantageously allowed for group members to audibly determine whether the speech token was available, (Maggenti, col. 6, lines 11-23, col. 31, lines 38-48).

40. In considering claim 25, although the teachings of Maggenti disclose substantial features of the claimed invention, they fail to expressly disclose: queuing the request for the speech token until the speech token is available.

Nevertheless, queuing was well known in the art at the time of the present invention. Also, Maggenti teaches denying a request for the speech token until the speech token is available, (col. 5, lines 26-37).

Thus, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Maggenti to show queuing the request for the speech token until the speech token is available, and processing the queued request to acquire the speech token when the speech token becomes available. This would have advantageously allowed for a user to receive the speech token when it becomes available by only pressing the PTT button once, (Maggenti, col. 6, line 47-col. 7, line 7).

41. In considering claims 26 and 36, Maggenti teaches a method for PTT private calls for users in a wireless communications network, comprising: selecting a called party private identification for a private call by a calling party on a mobile device, (col.

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20, lines 26-30); pressing a PTT button on the mobile device, (col. 20, lines 26-30); transmitting to request a speech token, (col. 6, lines 11-23); redirecting a request, (col. 25, lines 51-57); receiving an acknowledge message that includes a speech token, (col. 6, lines 11-23); transmitting calling party information from the PTT Server to the called party, (col. 12, line 64-col. 13, line 11); communicating speech packets from the calling party to the called party in a half-duplex manner, (col. 20, lines 26-30); releasing the PTT button on the mobile device, (col. 6, lines 11-23); transmitting to release the speech token, (col. 6, lines 11-23); notifying the calling and called parties that the group's speech token is available, (col. 6, lines 11-23, col. 31, lines 38-48). Maggenti also teaches operating over the SIP protocol, (col. 7, lines 39-57). Thus, it is implicit in the teachings of Maggenti that a SIP SUBSCRIBE is transmitted to the PTT server from the mobile device to request the group's speech token, since SIP SUBSCRIBE is a conventional method.

Although the teachings of Maggenti disclose substantial features of the claimed invention, they fail to expressly disclose: redirecting a SIP SUBSCRIBE to the PTT server for purposes or removing the calling party and the called party from a multicast group.

Nevertheless, the teachings of Maggenti provide a means for redirecting a SIP SUBSCRIBE to the PTT server for purposes or removing the calling party and the called party from a multicast group, (col. 6, line 62-col. 7, line 7, col. 20, lines 26-30, col. 25, lines 51-57).

Thus, if not implicit, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Maggenti to show redirecting a SIP SUBSCRIBE to the PTT server for purposes or removing the calling party and the called party from a multicast group. This would have advantageously provided a means for supporting a private call between a calling party and a called party, (Maggenti, col. 20, lines 26-30).

42. In considering claim 27, although the teachings of Maggenti disclose substantial features of the claimed invention, they fail to expressly disclose: transmitting the calling party information using a SIP NOTIFY message.

Nevertheless, NOTIFY messages were well known in the art at the time of the present invention for event notification after an explicit/implicit subscription.

Thus, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Maggenti to show transmitting the calling party information using a SIP NOTIFY message. This would have advantageously provided a conventional means for transmitting calling party information from the PTT Server to the called party, (Maggenti, col. 12, line 64-col. 13, line 11)

43. In considering claim 28, although the teachings of Maggenti disclose substantial features of the claimed invention, they fail to expressly disclose: transmitting the calling party information using an INFO message.

Nevertheless, INFO messages were well known in the art at the time of the present invention for mid-call signaling information exchanging.

Thus, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Maggenti to show transmitting the calling party information using an INFO message. This would have advantageously provided a conventional means for transmitting calling party information from the PTT Server to the called party, (Maggenti, col. 12, line 64-col. 13, line 11).

44. In considering claim 29, the teachings of Maggenti provide a means for sending a response to the SIP SUBSCRIBE that requested releasing of the private-call speech, (col. 31, lines 38-59).

45. In considering claim 33, the teachings of Maggenti provide a means for reinstating the calling party and the called party as part of the group upon termination of the private call, (col. 4, lines 49-59, col. 20, lines 26-30).

46. In considering claim 34, the teachings of Maggenti provide a means for restoring the IP addresses of the parties' mobile device to the group's multicast group, (col. 6, line 62-col. 7, line 7, col. 4, lines 49-59, col. 20, lines 26-30, col. 25, lines 51-57).

Double Patenting

47. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*

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Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

48. Claims 1 and 26, are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 37, of copending Application No. 10/137,551. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

49. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

50. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 16 of copending Application No. 10/028,091. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations "a Presence

Server operable to store data on active mobile devices” in claim 1 of the copending application, and “notifying members of the group of other members’ presence” in claims 5 and 16 would have been obvious modifications to one of ordinary skill in the art at the time of the present invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

51. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. “RFC 2543-SIP: Session Initiation Protocol”, Handley et al.; “Event Notification in SIP”, Roach; and “RFC 2976-The SIP INFO Method”, Donovan; - all disclose conventional SIP methods.

52. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is (571) 272-3940. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP/
9/21/05


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER